

### **REMARKS/ARGUMENTS**

Claims 1-44 are pending and claims 45-84 are canceled. Claims 1-43 stand substantively rejected and claim 44 is withdrawn. In this Amendment, claims 1, 42, and 43 are amended, and new claims 85-88 are added. Reconsideration is respectfully requested.

Applicant's undersigned representative thanks the Examiner for the courtesies extended during the telephone conference of May 26, 2010.

#### **Resubmission of Petition Under 37 CFR §1.53(e) Regarding Allegedly Omitted Items**

On December 20, 2004, Applicant filed a Petition for reconsideration of the Notice to File Missing Parts. As part of the Petition, Applicant provided evidence establishing that Figures 17A, 17B, and 17C were included the originally filed nonprovisional application papers on April 16, 2004.

However, the USPTO record currently indicates a Filing Date of December 20, 2004, and not April 16, 2004. Relatedly, the record does not indicate the USPTO acted on the Petition. Accordingly, Applicant respectfully request that the Office grant the Petition and assign a Filing Date of April 16, 2004 to the instant application.

#### **Claim Amendments**

Amended claims 1, 42, and 43 refer to the adjustment of surgery system parameters embodied within a data file, tangible storage media, or storage module. Support for these amendments can be found in the specification at, for example, paragraphs [0070], [0078], and [0079]. Support for new claims 85-87 can be found in the specification at, for example, paragraph [0199]. New claim 88 incorporates elements of amended claim 1. No new matter is introduced.

### **Rejection Under 35 U.S.C. §101**

Claims 1-43 were rejected under 35 U.S.C. §101 as allegedly drawn to non-statutory subject matter. This rejection is traversed.

#### Insignificant Extra-Solution Activity and Subject Matter Transformation

The Office Action alleges that within the scope of the machine-or-transformation test:

- a) the recited computer system (i.e. machine) involves insignificant extra-solution activity, and
- b) no transformation of subject matter occurs in the recited method steps.

The instant amendment is intended to address the transformation prong of the machine-or-transformation test. The USPTO guidelines involving transformation are discussed in the paragraph bridging pages 5 and 6 of the August 24, 2009 Memorandum from the Acting Deputy Commissioner for Patent Examination Policy, attached hereto as **Appendix A**.

In brief, the August 24, 2009 Subject Matter Instructions provide that:

*"[T]ransformation of electronic data has been found when the nature of the data has been changed such that it has a different function or is suitable for a different use." (Emphasis added).*

#### Transformation of Electronic Data

Amended independent claims 1, 42, and 43 involve a "a transformation of electronic data" that satisfies the requirements stated in the August 24, 2009 Interim Subject Matter Instructions, because the nature of the data has been changed such that it has a different function or is suitable for a different use.

For example, amended independent claim 1 indicates that a set of refractive surgery system parameters embodied within a data file is adjusted so as to inhibit an induced aberration. Hence, the data (e.g. set of system parameters within the data file) has been changed such that it has a different function or is suitable for a different use (e.g. adjusted so as to inhibit an induced aberration), and amended claim 1 can be read and construed consistently with the Interim Subject Matter Instructions.

Similarly, amended independent claim 42 indicates that a set of refractive surgery system parameters embodied within machine readable data is adjusted so as to alter an aberration distribution. Hence, the data (e.g. set of system parameters within the data) has been changed such that it has a different function or is suitable for a different use (e.g. adjusted so as to alter an aberration distribution), and amended claim 42 can be read and construed consistently with the Interim Subject Matter Instructions.

Likewise, amended independent claim 43 indicates that a set of refractive surgery system parameters embodied within a storage module is adjusted so as to inhibit an induced aberration. Hence, the data (e.g. set of system parameters within the module) has been changed such that it has a different function or is suitable for a different use (e.g. adjusted so as to inhibit an induced aberration), and amended claim 43 can be read and construed consistently with the Interim Subject Matter Instructions.

Based on the above, independent claims 1, 42, and 43 satisfy the “machine-or-transformation test.” Withdrawal of this rejection is respectfully requested.

### **CONCLUSION**

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

Appl. No. 10/825,864  
Amdt. dated May 28, 2010  
Amendment under 37 CFR 1.114  
Request for Continued Examination (RCE)

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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**Attachment:**

*Appendix A - August 24, 2009 Memorandum*

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